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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,409	10/01/2003	Thomas M. Fudali	66396-072	5122

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McDERMOTT, WILL & EMERY
600 13th Street, N.W.
Washington, DC 20005-3096

EXAMINER

BODDIE, WILLIAM

ART UNIT	PAPER NUMBER
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2629

MAIL DATE	DELIVERY MODE
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12/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/674,409

Applicant(s)

FUDALI ET AL.

Examiner

William L. Boddie

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 10-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. In an amendment dated, October 16th, 2007, the Applicant amended claims 3 and 4. Currently claims 1-9 are pending.

Response to Amendment

2. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

Response to Arguments

3. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-9 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As pertaining to claims 1-9, the Applicants have clearly communicated that the user interface claimed can take the form of "acoustic or light waves" and is simply a program. (paras. 28-30, 37).

Applicants are directed to page 53 of the Interim Statutory 101 Guidelines, which states; "computer programs claimed as computer listings per se i.e., the descriptions or expressions of the programs are not physical "things." They are neither computer components nor statutory processes, as they are not "acts" being performed."

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawasaki et al. (US 7,123,243) in view of Szukala et al. (US 6,801,849).

With respect to claim 1, Kawasaki discloses, a user interface for invoking a function of an instrument (fig. 5), the user interface comprising:

a first navigational menu (12a in fig. 5) including at least one display element (51 in fig. 5), the at least one display element having a touch sensitive active region (box surrounding the graphic in 51 in fig. 5) and a graphical representation of functionality invoked by user selection of the display element (graphic in 51 in fig. 5), wherein the touch sensitive active region includes more display area than the corresponding graphical representation (expressly disclosed as the white space surrounding the graphical representations).

Kawasaki does not expressly disclose, that the interface is for a diagnostic instrument or a second navigational menu.

Szukala discloses, a touch user interface (fig. 7a-b) for invoking a function of a diagnostic instrument (engine diagnostic), the user interface comprising:

a first navigational menu (fig. 7a-b) including at least one display element (each menu selection, static info...); and

a second navigational menu (fig. 11, for example) configured to be displayed responsive to contact on the touch sensitive active region of the at least one display element (Static Tests icon in fig. 7b), the second navigational menu including a selection group related to a test suite of the diagnostic instrument (fuel injector, ignition firing etc. in fig. 11).

Kawasaki and Szukala are analogous art because they are both from the same field of endeavor namely design of PDA touch user interfaces.

At the time of the invention it would have been obvious to one of ordinary skill in the art to use the instrument of Kawasaki as a diagnostic tool and include a second navigational menu as taught by Szukala.

The motivation for doing so would have been the need for a portable engine diagnostic device (Szukala; col. 2, lines 15-17) as well as the well-known benefit of providing a main menu and submenus to help a user more quickly reach the function they desire.

With respect to claim 2, Kawasaki and Szukala disclose, the user interface of claim 1 (see above).

Kawasaki, when combined with Szukala, further discloses, wherein the selection group includes a plurality of display elements (Szukala; fuel injector, ignition firing etc in fig. 11), each of the plurality of display elements having a touch sensitive active region to enable user selection of the plurality of display elements (Szukala; col. 13, lines 1-9).

With respect to claim 3, Kawasaki and Szukala disclose, the user interface of claim 1 (see above).

Kawasaki, when combined with Szukala, further discloses, wherein the selection group includes fewer than ten display elements to permit discrete touch sensitive selection of each of the fewer than ten display elements (Szukala; only 5 in fig. 11).

With respect to claim 4, Kawasaki and Szukala disclose, the user interface of claim 1 (see above).

Kawasaki further discloses, wherein the first navigational menu includes at least six display elements (nine in fig. 5), each of the at least six display elements having a discrete touch sensitive active region sized to permit finger tip selection (note the size of the icons in fig. 2 and their relation to the user's finger tips).

With respect to claims 7, Kawasaki and Szukala disclose, the user interface of claim 1 (see above).

Kawasaki further discloses, wherein the touch sensitive active region comprises an area having a polygonal shape (rectangle) of at least 1/4 square inch (see finger sized relation to the icon size in fig. 2, icons in fig. 2 are even smaller than icons shown in fig. 11).

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawasaki et al. (US 7,123,243) in view of Szukala et al. (US 6,801,849) and further in view of Banks et al. (US 6,603,494).

With respect to claim 5, Kawasaki and Szukala disclose, the user interface of claim 1 (see above).

Neither Kawasaki nor Szukala expressly disclose including a textual description of the functionality with the graphic.

Banks discloses, a diagnostic instrument, comprising a touch-based user interface, wherein at least one display element comprises

a textual description of functionality invoked by user selection of the display element (schedule, close, analyze, for example in fig. 5).

Banks, Kawasaki and Szukala are analogous art because they are from the same field of endeavor namely design of touch user interfaces.

At the time of the invention it would have been obvious to one of ordinary skill in the art to include textual descriptions alongside the graphics of Kawasaki and Szukala.

The motivation for doing so would have been the well-known benefit of removing any question in the user's mind what the graphic represents.

9. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawasaki et al. (US 7,123,243) in view of Szukala et al. (US 6,801,849) and further in view of Debrus et al. (US 5,598,527).

With respect to claim 6, Kawasaki and Szukala disclose, the user interface of claim 1 (see above).

Kawasaki further discloses, wherein the touch sensitive active region comprises a circular area with a diameter of at least 3/8 inch (3/8 inch diameter is almost half the size of a dime; Kawasaki discloses a space at the *very* least that large as seen in fig. 2).

Kawasaki and Szukala do not expressly disclose wherein the touch sensitive active region comprises an approximately circular shape.

Debrus discloses, a touch sensitive device wherein a touch sensitive active region (13-20 in fig. 1) comprises an approximately circular shape (see fig. 1) with a

diameter of at least 3/8 inch (col. 3, lines 27-30; 47 is approx. 6 inches long which equates to at least a diameter of at least 6/8 of an inch).

Debrus, Kawasaki and Szukala are analogous art because they are from the same field of endeavor namely, touch screen device design and implementation.

At the time of the invention it would have been obvious to one of ordinary skill in the art to size the display elements of Kawasaki and Szukala to permit finger tip selection as taught by Debrus.

The motivation for doing so would have been the well known benefit of allowing the user to more easily locate the icons.

The currently claimed differences in shape over Kawasaki and Szukala in view of Debrus are not seen as patentably distinct from the prior art. In short whether the touch regions are polygons or circular is immaterial and insignificant. The device will not perform differently should the user interface use polygons or circular shapes for the touch regions. The Applicant is directed to section 2144.04.IV.A-B of the MPEP.

10. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawasaki et al. (US 7,123,243) in view of Szukala et al. (US 6,801,849) and further in view of Ross et al. (US 5,859,628).

With respect to claim 8, Kawasaki and Szukala disclose, the user interface of claim 1 (see above).

Neither Kawasaki nor Szukala expressly disclose, wherein the touch sensitive active region comprises at least 1/10 of the screen area.

Ross discloses, a user interface (fig. 6d), and that the touch sensitive active region comprises at least 1/10 of the screen area (also clear from fig. 6d).

At the time of the invention it would have been obvious to one of ordinary skill in the art to size the display elements of Kawasaki and Szukala to span the entire display area as taught by Ross.

The motivation for doing so would have been to allow the user to more easily recognize the icons and text of the screen (Ross; col. 7, lines 11-12; for example).

11. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawasaki et al. (US 7,123,243) in view of Szukala et al. (US 6,801,849) and further in view of Cross et al. (US 7,154,481).

With respect to claim 9, Kawasaki and Szukala disclose, the user interface of claim 1 (see above).

Neither Kawasaki nor Szukala expressly disclose, wherein the first and second navigational menus are displayed on a touch screen device sized and positioned so as to be responsive to a gloved finger.

Cross discloses, a touch screen wherein the device is sized and positioned so as to be responsive to a gloved finger (col. 4, lines 47-49).

Cross, Kawasaki and Szukala are analogous art because they are from the same field of endeavor namely, touch screen device design and implementation.

At the time of the invention it would have been obvious to one of ordinary skill in the art to construct the touch screen of Kawasaki and Szukala in the manner of Cross to ensure that the device is responsive to a gloved finger.

The motivation for doing so would have been as a convenience and ease of use to the user to not have to remove any gloves in order to operate the machine. This is especially applicable to Kawasaki and Szukala, which is likely to be used in automobile repair centers where gloves are commonly worn.

Conclusion

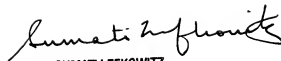
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Boddie whose telephone number is (571) 272-0666. The examiner can normally be reached on Monday through Friday, 7:30 - 4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sumati Lefkowitz can be reached on (571) 272-3638. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 2629

Wlb
12/5/07

A handwritten signature in black ink, appearing to read "Sumati Lefkowitz", with a stylized flourish at the end.

SUMATI LEFKOWITZ
SUPERVISORY PATENT EXAMINER